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The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte GERARDO KOBEH,
FRANK GODEBY,
JAMES KEITH HARMON, and
JOSEPH THOMPSON

Appeal 2009-012755
Application 10/673,431
Technology Center 3600

Before HUBERT C. LORIN, ANTON W. FETTING, and
JOSEPH A. FISCHETTI, *Administrative Patent Judges*.

LORIN, *Administrative Patent Judge*.

DECISION ON APPEAL[1]

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[1] The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, or for filing a request for rehearing, as recited in 37 C.F.R. § 41.52, begins to run from the "MAIL DATE" (paper delivery mode) or the "NOTIFICATION DATE" (electronic delivery mode) shown on the PTOL-90A cover letter attached to this decision.

STATEMENT OF THE CASE

Gerardo Kobeh, et al. (Appellants) seek our review under 35 U.S.C. § 134 of the final rejection of claims 1-27. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

SUMMARY OF DECISION

We AFFIRM-IN-PART.[2]

THE INVENTION

The invention is a "grants management systems and method that handle administrative and financial requirements of one or more sponsors." Specification [1].

Claim 1, reproduced below, is illustrative of the subject matter on appeal.

> 1. A computer-implemented grants management method for managing a plurality of grants for a recipient received from a plurality of grant sponsors, comprising:
>
> responsive to a transaction request and data associated therewith, converting values of the associated data from a domain of a transaction system to a domain defined for one of the plurality of grants,
>
> determining if the converted data maps to a classification that has been defined under the one of the plurality of grants to be valid,

[2] Our decision will make reference to the Appellants' Appeal Brief ("App. Br.," filed Dec. 29, 2008) and Reply Brief ("Reply Br.," filed Apr. 17, 2009), and the Examiner's Answer ("Answer," mailed Feb. 20, 2009).

> if so, determining, based on a set of rules derived from administrative and financial requirements of the plurality of grants and encoded in a database, if the converted data causes a limit defined under the one of the plurality of grants to be exceeded, and
>
> if not, admitting the requested transaction,
>
> otherwise, rejecting the requested transaction.

THE REJECTIONS

The Examiner relies upon the following as evidence of unpatentability:

Corrie	US 2002/0120538 A1	Aug. 29, 2002
Kanefsky	US 2005/0192826 A1	Sep. 1, 2005
Chen	US 7,111,010 B2	Sep. 19, 2006

The Examiner took official notice that "it is old and well known in the art to include multiple databases in systems that are operatively connected." Answer 19. [Hereinafter, Official Notice.]

The following rejections are before us for review:

1. Claims 1-10, 13-18, 20, and 22-27 are rejected under 35 U.S.C. §103(a) as being unpatentable over Corrie and Kanefsky.
2. Claims 11, 19, and 21 are rejected under 35 U.S.C. §103(a) as being unpatentable over Corrie, Kanefsky, and Official Notice.
3. Claim 12 is rejected under 35 U.S.C. §103(a) as being unpatentable over Corrie, Kanefsky, and Chen.

ISSUES

The first issue is whether claims 1-10, 14, 26 and 27 are unpatentable under 35 U.S.C. §103(a) over Corrie and Kanefsky. Specifically, the issue is whether Kanefsky teaches, as the Examiner asserts, the step of: responsive to a transaction request and data associated therewith, converting values of the associated data from a domain of a transaction system to a domain defined for one of the plurality of grants; and determining if the converted data maps to a classification that has been defined under the one of the plurality of grants to be valid. The rejection of claim 11 under 35 U.S.C. §103(a) as being unpatentable over Corrie, Kanefsky, and Official Notice and the rejection of claim 12 under 35 U.S.C. §103(a) as being unpatentable over Corrie, Kanefsky, and Chen also turn on this issue.

The second issue is whether claims 13, 15-18, 20, and 22-25 are unpatentable under 35 U.S.C. §103(a) over Corrie and Kanefsky. Specifically, the issue is whether Kanefsky's Provisional Application 60/496,816 provides proper support for the portions of Kanefsky cited by the Examiner to teach multiple grantees using a grant management system to manage grants from multiple grantors. The rejection of claims 19 and 21 under 35 U.S.C. §103(a) as being unpatentable over Corrie, Kanefsky, and Official Notice also turn on this issue.

FINDINGS OF FACT

We find that the following enumerated findings of fact (FF) are supported by at least a preponderance of the evidence. *Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 1427 (Fed. Cir. 1988) (explaining the general evidentiary standard for proceedings before the Office).

1. The Specification does not contain an express definition of "converting."
2. A definition of convert is "to change from one form or function to another." *See Merriam-Webster's Collegiate Dictionary* 253 (10th Ed. 1998.)(Entry for "convert.")
3. The Specification describes an example of converting the data as converting currency values. Specification [16].
4. Paragraph [0033] of Kanefsky describes the grantee entering data to the grant management service through a data entry module or the grantor entering grant setup information by importing it from an electronic file.
5. Figure 1 of Kanefsky is reproduced below.

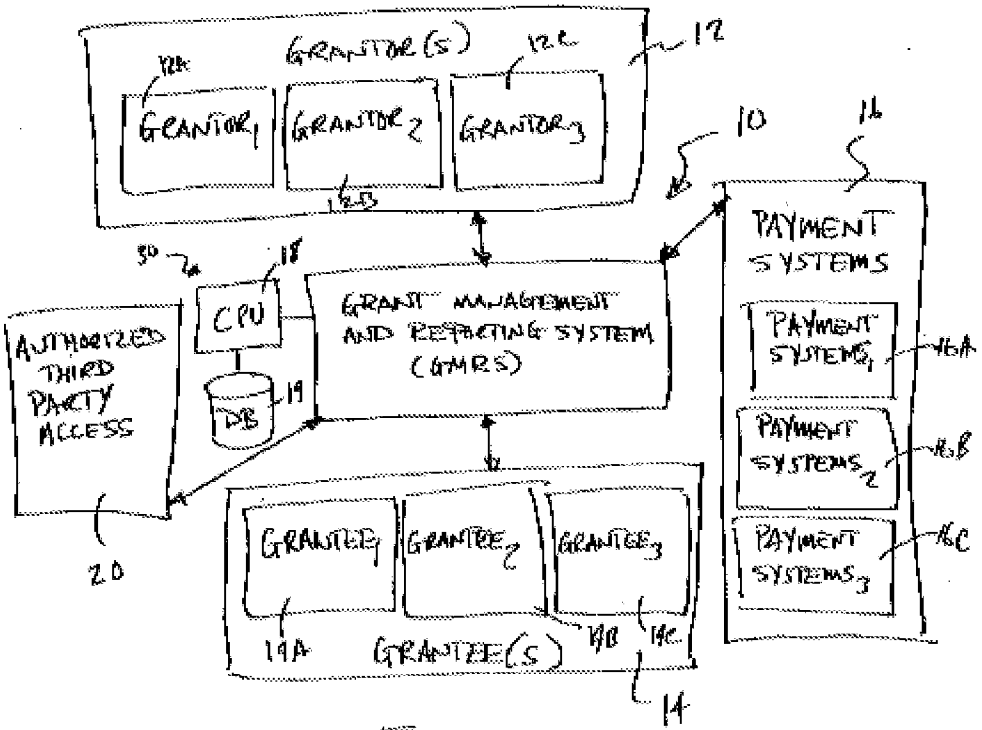
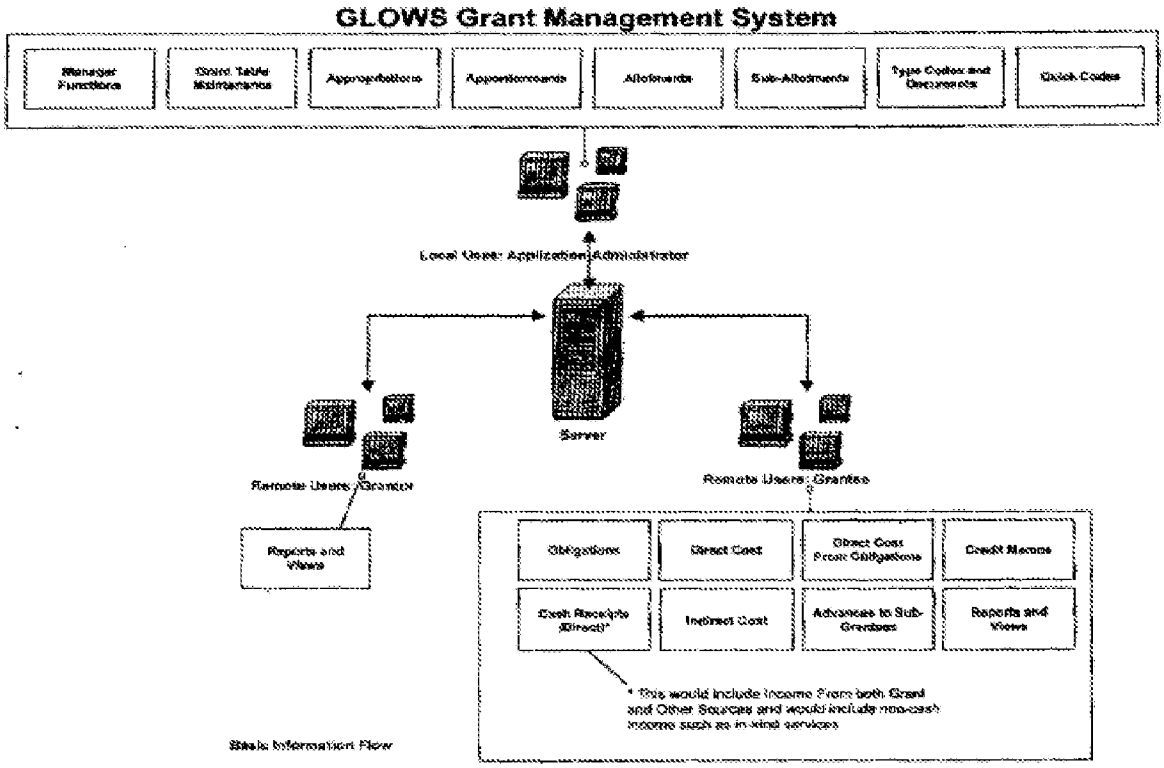


FIG. 1

Figure 1 depicts the overall architecture of Kanefsky's grant management system and depicts multiple grantors being connected to multiple grantees.

6. Paragraph [0021] of Kanefsky describes Figure 1 and also describes that multiple grantors and multiple grantees use the grant management and reporting system.

7. Page 67 of the 60/496,816 provisional application is reproduced below.



Page 67 depicts the overall architecture of a grant management system and depicts multiple grantees and grantors connected to the system.

8. Page 14 of the 60/496,816 provisional application, describes an embodiment of accessing the grant management system and states

"Grantees that access the system may choose by Grantor . . . All eligible Grants are displayed based on authorization."

ANALYSIS

The rejection of claims 1-10, 13-18, 20, and 22-27 under 35 U.S.C. §103(a) as being unpatentable over Corrie and Kanefsky.

Claims 1-10 and 27

Claim 1 states "responsive to a transaction request and data associated therewith, converting values of the associated data from a domain of a transaction system to a domain defined for one of the plurality of grants." To teach this limitation the Examiner cites paragraph [0033] of Kanefsky (Answer 29), which generally describes the grantee entering data to the grant management service through a data entry module or the grantor entering grant setup information by importing it from an electronic file (FF 4). Referring to the step of converting values of the associated data, the Examiner states: "Based on a broad and reasonable claim construction, the limitation in question imports transaction data by converting the respective data from a transaction file or folder to a file or folder defined for a specific grant." Answer 29-30. The Examiner seems to argue that this limitation, when broadly and reasonably construed, encompasses converting data by entering it into the grant management service or moving the data between files.

During examination of a patent application, a pending claim is given the broadest reasonable construction consistent with the specification and should be read in light of the specification as it would be interpreted by one

of ordinary skill in the art. *In re Am. Acad. of Sci. Tech Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004).

> [W]e look to the specification to see if it provides a definition for claim terms, but otherwise apply a broad interpretation. As this court has discussed, this methodology produces claims with only justifiable breadth. *In re Yamamoto*, 740 F.2d 1569, 1571 (Fed. Cir. 1984). Further, as applicants may amend claims to narrow their scope, a broad construction during prosecution creates no unfairness to the applicant or patentee. *Am. Acad.*, 367 F.3d at 1364.

In re ICON Health and Fitness, Inc., 496 F.3d 1374, 1379 (Fed. Cir. 2007). Limitations appearing in the specification but not recited in the claim are not read into the claim. *E-Pass Techs., Inc. v. 3Com Corp.*, 343 F.3d 1364, 1369 (Fed. Cir. 2003).

We find that the Examiner has unreasonably broadly construed this limitation. The Specification does not contain an express definition of "converting." FF 1. A definition of convert is "to change from one form or function to another." FF 2. We note that the Specification describes an example of converting the data as converting currency values. FF 3. Merely entering data into the grant management system or moving the data between files does not change the data from one form or function to another. Therefore, we find that the Examiner has unreasonably broadly construed the step of converting the data to encompass the uploading of the data described in Kanefsky.

Independent claims 6, 10, and 27 also recite similar limitations and our reasoning above equally applies to those claims. Accordingly, we find that the rejection of claims 1-10 and 27 under 35 U.S.C. 103(a) as being unpatentable over Corrie and Kanefsky is overcome.

Claims 13, 15-18, 20, and 22-25

The Appellants argued claims 13 and 15-18, 20, and 22-25 as a group. App. Br. 8-13. We select claim 13 as the representative claim for this group, and the remaining claims 15-18, 20, and 22-25 stand or fall with claim 13. 37 C.F.R. § 41.37(c)(1)(vii) (2009).

Independent claims 13, 20 and 23 do not recite limitations similar to the converting step addressed above. Therefore, the Appellants' arguments, with regard to the step of converting, are inapplicable to the rejection of these claims.

However, the Appellants also argue that Kanefsky is not available as prior art since Kanefsky's Provisional Application 60/496,816 does "not disclose a grant management system for a recipient (Grantee) to manage the expenditure of grants from multiple Grantors" but instead is merely concerned with a grant reporting system for a Grantor. App. Br. 9-10 and Reply Br. 2-5.

The Appellants correctly point out that Kanefsky has a filing date of August 20, 2004, which is after the filing date of the present application. App. Br. 9. However, Kanefsky claims priority under 35 U.S.C. § 119(e) to provisional application 60/496,816, filed Aug. 21, 2003, and that date is before the filing date of the present application. The test for determining whether Kanefsky may be relied upon is whether the 60/496,816 provisional application properly supported the subject matter relied upon to make the rejection in compliance with 35 U.S.C. § 112, first paragraph. We agree with the Examiner that it does.

In the rejection, the Examiner cites to Figure 1 and paragraph [0021] of Kanefsky to teach the limitation at issue. *See* Answer 11. Figure 1 depicts the overall architecture of Kanefsky's grant management system and depicts multiple grantors being connected to multiple grantees. FF 5. Paragraph [0021] describes Figure 1 and also describes that multiple grantors and multiple grantees use the grant management and reporting system. FF 6. The Examiner points to pages 2, 14, and 67-68 of the 60/496,816 provisional application as having the proper support for the claimed subject matter. Answer 28. Page 67, while not identical to Figure 1 of Kanefsky, also depicts the overall architecture of a grant management system and depicts multiple grantees and grantors connected to the system. FF 7. Further, page 14 of the 60/496,816 provisional application, describes an embodiment of accessing the grant management system and states "Grantees that access the system may choose by Grantor . . . All eligible Grants are displayed based on authorization." FF 8. Therefore, we find that the 60/496,816 provisional application does support the subject matter of Figure 1 and paragraph [0021] of Kanefsky related to multiple grantees accessing grants from multiple grantees through a grant management system.

Accordingly, we find that the Appellants have not overcome the rejection of claims 13, 15-18, 20, and 22-25 under 35 U.S.C. 103(a) being unpatentable over Corrie and Kanefsky.

Claims 14 and 26

Dependent claims 14 and 26 recite limitations similar to the limitation at issue with respect to claim 1 above. For the same reasons as discussed

above with respect to claim 1, we will not sustain the rejections of claims 14 and 26 over the cited prior art. Accordingly, we find that the rejection of claims 14 and 26 under 35 U.S.C. 103(a) over Corrie and Kanefsky is overcome.

The rejection of claims 11, 19, and 21 under 35 U.S.C. §103(a) as being unpatentable over Corrie, Kanefsky, and Official Notice.

As to claim 11, this rejection is directed to a claim indirectly dependent on independent claim 6 whose rejection we have reversed above. For the same reasons, we will not sustain the rejections of claim 11 over the cited prior art. *Cf. In re Fritch*, 972 F.2d 1260, 1266 (Fed. Cir. 1992) ("[D]ependent claims are nonobvious if the independent claims from which they depend are nonobvious.").

As to claims 19 and 21, we also shall sustain the standing 35 U.S.C. § 103(a) rejection of dependent claims 19 and 21 as being unpatentable over Corrie, Kanefsky, and Official Notice since the Appellants have not challenged such with any reasonable specificity, thereby allowing claims 19 and 21 to stand or fall with parent claims 13 and 20. (*see In re Nielson*, 816 F.2d 1567, 1572 (Fed. Cir. 1987)).

The rejection of claim 12 under 35 U.S.C. §103(a) as being unpatentable over Corrie, Kanefsky, and Chen.

This rejection is directed to a claim dependent on claim 10, whose rejection we have reversed above. For the same reasons, we will not sustain the rejection of claim 12 over the cited prior art. *Cf. In re Fritch*, 972 F.2d

1260, 1266 (Fed. Cir. 1992) ("[D]ependent claims are nonobvious if the independent claims from which they depend are nonobvious.").

DECISION

The decision of the Examiner to reject claims 1-12, 14, 26, and 27 is reversed and to reject claims 13 and 15-25 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv) (2007).

AFFIRMED-IN-PART

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